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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,554	08/19/2003	Ralf M. Luche	200125.413C1	8043

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SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 6300
SEATTLE, WA 98104-7092

EXAMINER

PATTERSON, CHARLES L JR

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/644,554

Applicant(s)

LUCHE ET AL.

Examiner

Charles L. Patterson, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,15-21 and 26-98 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1,15-21 and 26-98 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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Restriction to one of the following inventions is required under 35

U.S.C. 121:

- I. Claims 1, 26-29 and 47-49 drawn to a DSP-5 polypeptide, a method for screening for an agent that modulates DSP-5 activity and a method of screening a molecule for the ability to interact with DSP-5, classified in class 435, subclasses 21 and 196.
- II. Claims 15-21, drawn to an antibody, a pharmaceutical composition comprising the antibody and a method of use of the antibody, classified in class 435, subclass 7.4 and class 530, subclass 387.9.
- III. Claims 30-32 and 42, drawn to a method for screening for an agent that modulates DSP-5 activity, classified in class 435, subclass 6.
- IV. Claims 33 and 36-39, drawn to a method for modulating a proliferative response in a cell, classified in classes 424 and 514, numerous subclasses.
- V. Claim 34 and 36-39, drawn to a method for modulating differentiation of a cell, classified in classes 424 and 514, numerous subclasses.
- VI. Claim 35-41, drawn to a method for modulating survival of a cell, classified in classes 424 and 514, numerous subclasses.
- VII. Claims 43-44, drawn to a method for treating a patient afflicted with a disorder associated with DSP-5 activity, classified in classes 424 and 514, numerous subclasses.
- VIII. Claims 45-46, drawn to a DSP-5 substrate trapping mutant polypeptide, classified in class 530, subclass 350.

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- IX. Claims 50, 75-78 and 96-98 drawn to a DSP-5 alternate form polypeptide, a method for screening for an agent that modulates DSP-5 alternate form activity and a method of screening a molecule for the ability to interact with DSP-5 alternate form, classified in class 435, subclasses 21 and 196.
- X. Claims 51-63 and 71-74 drawn to a polynucleotide, a vector containing the polynucleotide, a host cell containing the vector, an antisense polynucleotide, a method of producing DSP-5 alternate form by using the host cell and a method of detecting DSP-5 expression, classified in class 435, subclasses 196, 320.1, 252.3 and class 536, subclasses 23.2 and 24.3.
- XI. Claims 64-70, drawn to an antibody, a pharmaceutical composition comprising the antibody and a method of use of the antibody, classified in class 435, subclass 7.4 and class 530, subclass 387.9.
- XII. Claims 79-81 and 91, drawn to a method for screening for an agent that modulates DSP-5 alternate form activity, classified in class 435, subclass 6.
- XIII. Claims 82 and 85-88, drawn to a method for modulating a proliferative response in a cell, classified in classes 424 and 514, numerous subclasses.
- XIV. Claims 83 and 85-88, drawn to a method for modulating differentiation of a cell, classified in classes 424 and 514, numerous subclasses.
- XV. Claims 84-90, drawn to a method for modulating survival of a cell, classified in classes 424 and 514, numerous subclasses.

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XVI. Claims 92-93, drawn to a method for treating a patient afflicted with a disorder associated with DSP-5 alternate form activity, classified in classes 424 and 514, numerous subclasses.

XVII. Claims 94-95, drawn to a DSP-5 alternate form substrate trapping mutant polypeptide, classified in class 530, subclass 350.

Note that Groups IV-VI contain claims 36-39 and Groups XIII-XV contain claims 85-88.

The inventions are distinct, each from the other because:

Groups I-VIII are drawn to subject matter concerning DSP-5 while groups IX-XVII are drawn to subject matter concerning DSP-5 alternate form. The two DSP forms are different proteins and therefore are patentably distinct.

Groups I-II, VIII-XI, and XVII are drawn to completely different chemical compounds that are patentably distinct.

The methods of Groups III and XII involve a DSP-5 or DSP-5 alternate form promoter and are unrelated to any of the other groups.

Groups IV-VI and XII-XV involve contacting a cell with an unspecified agent that modulates DSP-5 or DSP-5 alternate form activity and are unrelated to any other groups. Groups VII and XVI involve administering to a patient an unspecified agent that modulates DSP-5 or DSP-5 alternate form activity and are unrelated to any other of the groups.

Groups VIII and XVII are drawn to DSP-5 or DSP-5 alternate form substrate trapping mutant proteins that have reduced activity, including no activity. The instant proteins are chemically different from the polypeptides of Groups I and IX and are patentably distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different clas-

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sification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., PhD, whose telephone number is 571-272-0936. The examiner can normally be reached on Monday - Friday from 7:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Charles L. Patterson, Jr.
Primary Examiner
Art Unit 1652

Patterson
July 28, 2005